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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,968	11/06/2001	Carlos Miguel Carcagno	1909.0040002	7301

7590 03/21/2007  
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EXAMINER
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KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
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1633

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/830,968

**Applicant(s)**

CARCAGNO ET AL.

**Examiner**

Sumesh Kaushal Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's response filed on 12/20/06 has been acknowledged.

*Claims 1-5, 7-13 and 15-20 are pending and are examined in this office action.*

*Applicants are required to follow Amendment Practice under revised 37 CFR §1.121. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The references cited herein are of record in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-5, 7-13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (new matter). The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reason of record as set forth in the office action mailed on 09/21/06.

#### **Response to argument (new mater)**

The applicant argues that the specification as-filed provides adequate written descriptive support under 35 U.S.C. §112, first paragraph, for a "culture medium consisting of DMEM (Dulbecco's modified Eagle's medium), FI2 medium, insulin and an additive, wherein the additive is selected from the group consisting of NaHCO<sub>3</sub>, sugars, ethanolamine, pyruvate, amino acids and mixtures thereof."

The applicant further argues that more specifically, originally filed claims 1 and 6 were drawn to a method for obtaining human erythropoietin (hereinafter "EPO")

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comprising culturing mammalian cells which express recombinant EPO in culture medium comprising insulin (claim 1) and the culture medium is fetal-calf serum free (claim 6). The originally filed claims are broadly drawn to fetal-calf serum free (hereinafter "SF") culture media comprising insulin, while the culture media disclosed on page 14 of the instant specification, comprises DMEM, F12 and insulin in addition to additives. The instant specification provides descriptive support for a wide range of SF culture media. Thus, the written description is commensurate with the scope of the invention as claimed.

However this is found not persuasive. As stated in the earlier office action the specification page 14 of the instant application fails to disclose a culture media that consist of DMEM (Dulbecco's modified Eagle's medium), F12 medium, insulin and one or more additives selected from the group consisting of  $\text{NaHCO}_3$ , sugars, ethanolamine, pyruvate, amino acids and mixtures thereof'. The scope of culture media as claimed herein is broader than the culture media disclose on page 14 (see culture media no.3).

As MPEP 2163.06 notes "

*Culture Medium no. 3  
Basal Culture Medium + Insulin*

ISCOVE'S DNEM	8.85 g/l	Tryptophan	27mg/l
HAM F12	5.35 g/l	Asparagine	40mg/l
$\text{NaHCO}_3$	2.10 g/l	Serine	80mg/l
Glucose	1.30 g/l	Ethanolamine	3mg/l
Lactose	0.20 g/l	Glutamine	0.20 mg/l
Galactose	0.20 g/l	Sodium Pyruvate	0.11 g/l
Glutamine	1.90 g/l	Insulin	10 mg/l

If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." So claims 1-5, 6-13 and 15-20 are

apparently new matter. A careful review by the examiner of the specification failed to identify any support for this new limitation *i.e. culture media that consist of DMEM (Dulbecco's modified Eagle's medium), F12 medium, insulin and one or more additives selected from the group consisting of  $\text{NaHCO}_3$ , sugars, ethanolamine, pyruvate, amino acids and mixtures thereof.* Since no basis has been found to support the new claim limitation in the specification, the claims are rejected as incorporating new matter.

Claims 1-5, 7-13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reason of record as set forth in the office action mailed on 09/21/06.

#### **Nature Of Invention**

The instant invention relates to large scale production of recombinant production of rEPO in mammalian cells

#### **Breadth Of Claims And Guidance Provided in the Specification**

The scope of invention as claimed encompasses a method for obtaining human erythropoietin comprising culturing mammalian cells which express recombinant human erythropoietin in culture medium consisting of DMEM, F12 medium, insulin and an additive selected from the group consisting of NaHCO<sub>3</sub>, sugars, ethanolamine, pyruvate, amino acids and mixtures thereof. At best the specification teaches maintaining growth and proliferation of recombinant CHO(rEPO) cells using a culture media containing Fetal calf serum followed by harvesting of rEPO in a serum free media. The specification fails to disclose growth and proliferation of recombinant CHO, COS, BHK, Namalwa and HeLa cells for the production of rEPO in serum free culture media (as claimed).

#### **Response to Argument (Enablement)**

The applicant argues that example 1 of the instant discloses the use of CHO cells transfected with EPO, the expansion of the cells (Examples 2-5), and the incubation with SF media (page 14 of the instant specification). The applicant argues that accordingly, the instant specification provides at least one working example that falls within the scope of the instant claims. The applicant argues that Wang et al, Yang et al, Schroder and Lee et al provide teaching that there are many serum free culture media that would allow the production of recombinant proteins in the cell culture.

The applicant argues that the office fails to provide any evidence that the claimed method will not obtain EPO from a "culture medium consisting of DMEM (Dulbecco's

modified Eagle's medium), F12 medium, insulin and an additive, wherein the additive is selected from the group consisting of  $\text{NaHCO}_3$ , sugars, ethanolamine, pyruvate, amino acids and mixture. The applicant argues that specification in examples 6-8 provide a method of culturing the mammalian cells under serum free conditions to produce EPO. The applicant argues that contrary to the office's assertion, the references Wang et al., Yang et al., Schroder et al. and Lee et al. do not show that the state of the art is unpredictable for the production of recombinant proteins, specifically EPO, in cell culture using SF media and states that the CHO-SFM2.1 SF medium of Wang et al. and Yang et al. was specifically developed for specific CHO cell lines producing EPO.

The applicant argues that even if different culture conditions have different effects because of the differences in various metabolites produced, this does not mean that the culture methods of the instantly claimed invention are unpredictable and would require undue amount of experimentation for COS, BHK, Namalwa and Hela cells in the context with the production of rEPO in serum free culture. The applicant argues that considering the state of the art and guidance provided in the specification any experimentation required to practice the present invention would have been reasonable, not undue.

However applicant arguments are found not persuasive because the scope of culture medium as claimed (for example) is limited to DMEM, F12, insulin and  $\text{NaHCO}_3$ , which render the use such medium highly unpredictable as it is well established in the tissue culture art that cell requires glucose and amino acids to proliferate and produce recombinant proteins. The specification as filed fails to disclose any cell culture cultured only in DMEM, F12, insulin and  $\text{NaHCO}_3$ , which is capable of producing recombinant human EPO. The state of art at the time of filing teaches various factors affect the production of recombinant proteins in serum free medium. Several culture parameters could affect the metabolism of cultured cells and hence affect the glycosylation and sialylation of secreted glycoproteins. These factors include combination of nutrition, concentration and accumulation of by products. (see Wang et al Biotechnol Bioeng. 77(2):194-203. 2002, Yang et al, Biotechnol Prog. 18(1):129-38., 2002 Schroder et al J Biotechnol. 108(3):279-92, 2004). Therefore the combination of essential nutrients

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(sugars, salts and growth factors etc) and their concentration varies not only with choice of host cells but also depends upon the selection of culture conditions. Furthermore the scope of culture media claimed is not limited to composition described in the Wang et al., Yang. et al., Schroder et al. and Lee et al.

Contrary to the applicants assertion Wang et al clearly teach that even optimization of culture conditions would encompasses undue experimentation (see page 194, col-2, page 195 col.1)

However, there is no universal approach to optimize conditions for all animal cell culture systems. Each bioprocess must be optimized with respect to a specific set of parameters. These include cell growth, cell yield, specific productivity as well as the ability to generate a product of consistent bioactivity and chemical structure. As most of the recombinant products of animal cells are glycoproteins, the consistency of glycosylation is also extremely important during production.

EPO is a glycoprotein of 165 amino acids with three N-linked and one O-linked glycan chains. The oligosaccharide moiety comprises up to 40% of the molecular weight of huEPO. The degree of glycosylation of huEPO, particularly the sialylation, is correlated with the in vivo bioactivity of EPO (Fukuda et al., 1989 Wasley et al., 1991). Asialo-EPO or nonglycosylated has only limited therapeutic value because it is rapidly cleared from the blood stream by the liver as a result of specific binding to a lectin receptor. Therefore, an important criterion in the development of a bioprocess for EPO production is to ensure conditions that maintain a normal pattern of glycosylation (Wasley et al., 1991).

A number of parameters of cell culture could affect the glycosylation and sialylation of secreted glycoproteins. These include nutrient concentration, accumulation of by-products (Borys et al., 1994; Yang and Butler, 2000), pH (Borys et al., 1993, 1994), and dissolved oxygen (Jan et al., 1997). Although several reports have shown the suitability of the Cytopilot fluidized-bed bioreactor culture system for growing a variety of cell lines (Goldman et al., 1998; Klima et al., 1997; Kong et al., 1999; Muller et al., 1997; Reiter et al., 1991; Unerluggauer et al., 1992; Valle et al., 1998), few have studied cell metabolism and the quality of the resulting cell product. Several culture parameters could affect the metabolism of the cultured cells and hence the glycosylation of the secreted product. Of particular concern in the Cytopilot is the possibility that gradient effects could result in a decrease of dissolved oxygen, nutrients, or pH within the macroporous beads resulting in inefficient metabolism and product processing (Preissmann et al., 1997).

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Similarly Yang et al teaches the importance of culture conditions that affects the glycosylation of the recombinant proteins (see page 136, col.2)

The glycosylation of recombinant proteins produced from mammalian cell lines in culture is essential for their therapeutic activity (Goochee et al., 1991). The carbohydrate chains on the protein can affect solubility, susceptibility to proteases, and especially bioactivities. Furthermore, it is important to maintain a consistent profile of glycoforms during a large-scale bioprocess (Jenkins and Curling, 1994). However, the mammalian cell culture conditions that affect the extent of glycosylation of a producer cell line are not well understood. In this work

Similarly Lee et al teaches that nutritional requirement of mammalian cell is so complex that it would require an undue amount of experimentation to practice any serum free condition (see page 86, col.1)

The nutritional requirements of mammalian cells are so complex that extensive efforts have been made to identify suitable serum-substituting supplements (Castro et al., 1992). The classical approach of changing one medium component at a time is still being used but becomes impractical because it is time-consuming and has the risk of neglecting interactions among supplements

At issue, under the enablement requirement of 35 U.S.C. 112, first paragraph is whether, given the Wands-factors, the experimentation was undue or unreasonable under the circumstances. "Experimentation must not require ingenuity beyond that to be expected of one of ordinary skill in the art." See *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1970). In the instant case besides the set of sequential culture conditions that sustains the growth and proliferation of CHO cells (in order to produce rEPO), the specification as filed fails to disclose any other culture conditions (i.e. composition of nutrients used) for COS, BHK, Namalwa and HeLa cells especially context with the production of rEPO in serum free culture media as claimed. The state of the art clearly teaches that adaptation of cell lines to serum free conditions is critical step in order to sustain viability and growth of recombinant cells, which not only requires stepwise weaning of serum conditions but also the addition of various additives to the culture media in order to produce a particular recombinant protein of interest.

The office has met the burden of establishing the fact that the method of obtaining hu-rEPO under culture conditions as claimed is highly unpredictable in view of the state of art, which clearly emphasize the role of various nutrients. The USPTO does not have laboratory facilities to test if an invention will function as claimed when working examples are not disclosed in the specification, therefore, enablement issues are raised and discussed based on the state of knowledge pertinent to an art at the time of the invention, therefore skepticism raised in the enablement rejections are those raised in the art by artisans of skill.

Furthermore, It is noted that patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable (See *Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966), Stating, in context of the utility requirement, that "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.") Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

*In instant case large scale industrial production of rEPO in serum free conditions (as claimed) is not considered routine in the art and without sufficient guidance to the host cells, contents and concentrations in the culture media used the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See In re Wands 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988). It is noted that the unpredictability of a particular area may alone provide reasonable doubt as to the accuracy of the broad statement made in support of enablement of claims. See Ex parte Singh, 17 USPQ2d 1714 (BPAI 1991). Therefore considering the state of the art and limited amount of guidance provided in the instant specification, one skill in the art would have to engage in excessive and undue amount of experimentation to exercise the invention as claimed.*

Claims 1-5, 7-13 and 15-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reason of record as set forth in the office action mailed on 09/21/06.

The applicant argues that current amendment to claim 1 has overcome the instant rejection. However, applicant's arguments are found not persuasive. The claim 1 recites the broad recitation "*an additives selected from the group consisting of NaHCO<sub>3</sub>, sugars, ethanolamine, pyruvate, amino acids and mixtures thereof*, and on the other hand the instant claim also recites culture media "consisting of" which is the narrower statement of the range/limitation. The MPEP clearly states that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c).

Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), *In re Van Guens*, 988 F.2d 1181, 26 PSPG2d 1057 (Ded. Cir. 1991), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim. Accordingly, without the recitation of all these critical limitations, the claims do not adequately define the instant invention. Similarly in the instant case the claims fails to recite what consists the "culture medium" as claimed.

In addition if the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand **how to avoid infringement**, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). See MPEP 173.02. In instant case it is unclear how one would envision the invention as claimed to avoid infringement issues especially in context with the contents of the "culture medium" as claimed.

### ***Double Patenting***

Claims 1-5, 6-13 and 15-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-13 of U.S. Patent No. 6,777,205, for the same reasons of record as set forth in the office action mailed on 12/29/05.

The applicant states that to advance prosecution, Applicants will submit a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c) upon the notification by the Examiner of allowable subject matter

### ***Conclusion***

No claims are allowed.


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 571-272-0769. The examiner can normally be reached on Mon-Fri. from 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**SUMESH KAUSHAL**  
**PRIMARY EXAMINER**